

REMARKS

Claims 1-11 are pending in the current application. No new matter has been added.

In view of the following remarks, favorable reconsideration and withdrawal of the restriction requirement is respectfully requested.

RESTRICTION REQUIREMENT

The Examiner required restriction of one of the following inventions:

- I. Claims 1-2, and 11, are drawn to a product, classified in class 430, subclass 270.1.
- II. Claims 3-10, are drawing to a method, classified in class 430, subclass 311.

In response to the Examiner's restriction/election requirement, Applicant elects, with traverse, to prosecute *Group I* including claims 1-2 and 11. Applicant specifically reserves the right to file a divisional application directed to non-elected claims 3-10.

With respect to Applicant's traversal, the technical feature of Group II (Claims 3-10) is to use the composition according to claim 1 in a general process of forming a pattern of metal alloy or oxide thereof. Claims 3-10 are dependent upon claim 1. The present method described in claims 3-10 cannot be practiced with another materially different product contrary to the Examiner's assertion in the Office Action, because claims 3-10 depend upon claim 1. In this regard, Applicant respectfully submits that the Restriction Requirement is not proper.¹

Furthermore, Applicant respectfully directs the Examiner's attention to M.P.E.P. § 803 which states:

¹ See MPEP § 806.05(f) ("A product defined by the process by which it can be made is still a product claim and can be restricted from the process if the Examiner can demonstrate that the product as claimed can be made by another materially different process; defining the product in terms of a process by which it is made is nothing more than a permissible technique that Applicant may use to define the invention"). Emphasis added.

"If the search and examination of an entire application can be made without serious burden, the Examiner must examine on the merits, even though it includes claims too distinct or independent invention."

Emphasis Added.

There are two criteria for a proper requirement for restriction. The invention should be independent or distinct, and

"2) there must be a serious burden on the Examiner if a restriction is not required. See M.P.E.P. §§ 803.092, 806.04 A-J, 808.01(a) and 808.02." Emphasis Added.

Applicants submit that a) claims 1-2 and 11 are not independent from claims 3-10 at least because of their dependency and patentability as discussed above, and b) burden cannot be demonstrated at least by the Office Action dated May 17, 2006, in which all of the pending claims were considered.

For all of the above stated reasons, reconsideration and withdrawal of the outstanding restriction/election requirement and favorable allowance of Groups I and II in the instant application are earnestly solicited.

Pursuant to 37 C.F.R. §§ 1.17 and 1.136(a), Applicant(s) hereby petition(s) for a one (1) month extension of time for filing a reply to the outstanding Office Action and submit the required \$120.00 extension fee herewith.

In the event the Restriction Requirement is not withdrawn, the Examiner is respectfully requested to contact the undersigned at (703) 668-8000 to discuss the matter.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 08-0750 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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By _____

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